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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,507	01/28/2004	Edwin L. Kinney	T60 . 12-0001	3507

7590 04/07/2005

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EXAMINER
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NGUYEN, SON T

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary****Application No.**

10/766,507

**Applicant(s)**

KINNEY ET AL.

**Examiner**

Son T. Nguyen

**Art Unit**

3643

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 10-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/28/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. In response to a election of species requirement mailed on 1/31/05, Applicant has elected Species I, which claims 1-9,13-16 are readable upon.

#### ***Information Disclosure Statement***

2. The information disclosure statement filed 7/1/2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-9,13,14,16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Benfield (US 541956 on form PTO-1449).

For claims 1,14,16, Benfield teaches a horseshoe comprising a top side; a bottom side engaging a support surface; a front end having a toe region, and two spaced side wall portions; and a plurality of calks (a<sup>1</sup>) on each of the side wall portions, each calk comprising a leading end (fig. 2, the pointed end) and having a rearwardly expanding outer surface (fig. 2, the conical expanding surface) protruding from the bottom side and having a rear surface (fig. 2, where ref. b is pointing at) extending from

Art Unit: 3643

the side wall portions, the rear surface being generally transverse to a fore and aft line between the side wall portions. However, Benfield is silent about the calk having a rounded leading end. It would have been an obvious substitution of functional equivalent to substitute the pointed leading end of the calk of Benfield with a rounded leading end, since both pointed and/or rounded leading end would perform the same function to provide grip for the horse on a surface.

For claim 2, Benfield teaches wherein the side wall portions and front end have a wall surface on an inner side that slopes at an angle downwardly and faces toward the bottom side (figs. 1,2, ref. b is the sloping surface).

For claim 3, Benfield teaches wherein the horseshoe is made out of metal (left column, line 19).

For claim 4, Benfield teaches wherein each of the side wall portions has two calks spaced in fore and aft direction (see figs. 1,3).

For claim 5, Benfield teaches wherein each of the side wall portions has three calks spaced from each other in fore and aft directions (see figs. 1,3).

For claim 6, Benfield teaches wherein the wall surface that slopes outwardly is concave (as in curving configuration of the horseshoe).

For claim 7, Benfield teaches wherein each calk has an outer surface tapering from the leading end to a larger size in rearward direction (see fig. 2, conical like). As for the rounded leading end, see explanation from claim 1.

For claim 8, Benfield teaches wherein the calks are supported on the wall surface that slopes outwardly and extend inwardly and downwardly from the wall surface (see figs. 1,2).

For claim 9, Benfield teaches wherein the rear surface on at least one calk is a flat surface substantially perpendicular to a plane defined by the bottom side of the horseshoe (see fig. 2).

For claim 13, Benfield teaches wherein the calks are solid elongated bodies that protrude from the sidewall portions and are to the interior of the sidewall portions of the horseshoe, a part of each of the calks protruding below the plane defined by the bottom surfaces (see figs. 1,2).

5. **Claim 15** is rejected under 35 U.S.C. 103(a) as being unpatentable over Benfield (as above) in view of Smith (US 3548947 on form PTO-1449).

Benfield is silent about a toe grab. Smith teaches a horseshoe comprising a toe region 116 having a toe grab 122 protruding below the bottom side; calks 130 extending inwardly from the interior portion and downwardly to protrude below the bottom side substantially equal to the protrusion of the toe grab (see fig. 1, refs. 120,130 are of equal protrusion depth). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a toe grab that is substantially equal to the protrusion of the calks as taught by Smith in the horseshoe of Benfield in order to provide traction in the toe region and to provide a stable traction horseshoe by having both the toe grab and the calks being equal in protrusion depth so as to stabilize the shoe and prevent unevenness on the support surface.

Art Unit: 3643

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is 571-272-6889. The examiner can normally be reached on Mon-Thu from 10:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Son T. Nguyen  
Primary Examiner  
Art Unit 3643

stn